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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,374	06/15/2000	Donald C.D. Chang	PD-200092	8501

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THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
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EXAMINER	
DAVIS, TEMICA M	

ART UNIT	PAPER NUMBER
2681	

DATE MAILED: 05/21/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/594,374	CHANG ET AL.	
	Examiner	Art Unit	
	Temica M. Davis	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 2, 5 and 9-12 have been considered but are moot in view of the new ground(s) of rejection. Applicants arguments with respect to claims 7-8 have been considered but they are not persuasive.

Regarding claim 6, the applicant argues that the uplink and the downlink in Tuck are part of the same payload and not a secondary payload. The examiner, however, disagrees. In its broadest sense, the primary and secondary payload reads on the uplink and the downlink described in Tuck, in that the links carry different information (i.e., processed information from the user terminal to the platform (uplink) and processed information from the platform to the user (downlink). Therefore, as presently claimed, Tuck reads on the limitations of claim 6.

Regarding claim 7, the applicant argues that a second stratospheric platform is more than just a mere duplication of parts, in that in such systems user terminals must be configured to receive the beam from the second stratospheric. However, claim 7 does not tie in the use of a second stratospheric with a user terminal. This limitation, as presently claimed, is a duplication of the first platform presented in claim 6.

Based on the remarks as described above, the rejection to claims 6-8 stands.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2 and 5 -13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3 and 5 of U.S. Patent No. 6,725,013. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to a communication system for use with geosynchronous satellite system broadcasting a first beam at a first frequency.

Specifically, claims 1 and 9 of the present invention and claims 1 and 3 of the above mentioned patent application both discuss a first stratospheric platform generating a second beam and a second stratospheric platform generating a third beam.

Regarding claim 2 of the present application, it contains similar subject of claim 2 of the patent mentioned above.

Regarding claims 5 and 10 of the present application, it contains similar subject matter of claim 5 of the above mentioned patent.

Regarding claims 6-8, it contains similar subject matter of claims 1, 4 and 5 of the above mentioned patent.

4. Claims 14-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3 and 5 of U.S. Patent No. 6,725,013. Although the conflicting claims are not identical, they are not patentably distinct from each other both inventions are drawn to a communication system for use with geosynchronous satellite system broadcasting a first beam at a first frequency.

Regarding claims 14-19 of the present invention, they contain similar subject matter of claims 1, 2, 3 and 5 of the above mentioned patent.

The patent, however, fails to disclose the platform generating fourth beams. The examiner contends that at the time of invention, such a feature would have been obvious to a person of ordinary skill in the art for the purpose of providing more coverage, thereby, allowing more users to communicate in the system.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuck, U.S. Patent No. 5,584,047.

Regarding claim 6, Tuck discloses a communication system for use with a communication system for use with geosynchronous satellite systems broadcasting a first beam at a first frequency comprising a first stratospheric platform having a primary payload (uplink 68; figure 10B) and a secondary payload (downlink 26; figure 10B), said secondary payload generating signals having the first frequency.

Regarding claim 8, Tuck discloses a system as recited in claim 6 wherein the communication signals are generated from a secondary payload (wherein the second beam is the microwave energy in downlink 26; figure 10B).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuck.

Regarding claim 7, Tuck discloses a system as recited in claim 6. Tuck, however, fails to disclose a second stratospheric platform generating a third beam having the first frequency.

However, it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Tuck to include a second platform so as to increase system coverage.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grayson et al, U.S. Patent No. 6,731,931.

Wang et al, U.S. Patent No. 6,622,006.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached Monday-Friday (alternate Fridays) from 9:00am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Davis
Examiner
Art Unit 2681

May 17, 2004

TEMICA M. DAVIS
PATENT EXAMINER